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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/667,981 | 09/22/2003 | Johan Loccufier | 27500-GN02117 | 1973 |

7590 07/13/2007
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EXAMINER

SCHWARTZ, PAMELA R

| ART UNIT | PAPER NUMBER |
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1774

| MAIL DATE | DELIVERY MODE |
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07/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 10/667,981 | Applicant(s) LOCCUFIER ET AL. | |
| | Examiner Pamela R. Schwartz | Art Unit 1774 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,9-11,13-15,17-23,25 and 28-46 is/are pending in the application.
 4a) Of the above claim(s) 18-23,25 and 29-46 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9-11,13-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3,5-7,9-11,13-15,17-23,25 and 28-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claim 28 is allowed.
2. Newly submitted claims 34-44 (since it depends from claim 41, it is assumed that claim 42 was intended to be directed to a process for providing light-stabilized ink-jet prints rather than to an ink-jet recording material) to a process for providing light-stabilized ink-jet prints and claims 45 and 46 directed to an ink-jet print are each directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions of elected claims 1-3, 5-7 and 9-11 and claims 34-44 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product can be used in a materially different process such as the process of writing with an ink pen or a lead pencil.

Inventions of elected claims 1-3, 5-7 and 9-11 and claims 45 and 46 are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as a medium for receiving an image from a ball point pen or a lead pencil and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

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Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 34-46 (as well as claims 18-23, 25 and 29-33 which were previously withdrawn from consideration) are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Claims 1-3, 5-7, 9-11, 13-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satou et al (6,808,768) in view of Avar (4,730,017). The primary reference discloses porous inorganic particles that can be silica, alumina, or other metal compounds and at least one ink absorbing layer containing the disclosed particles (col. 4, lines 28-43 and col. 7, lines 14 to col. 8, line 18). The binder of the layer(s) may be polyvinyl alcohol, polyamide, polyester, styrene butadiene, or others, including combinations of the disclosed binders. The layer may also contain a hindered amine light stabilizer. The secondary reference discloses particular light stabilizers, including some within the scope of applicants' claims, that stabilize polymeric materials including polyester, polyamide and styrene/butadiene (see col. 1, lines 5-7, formula II at the bottom of col. 2, when R₉ is di-substituted by OH, col. 2, lines 50-68 and col. 8, line

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34-56). It would have been obvious to one of ordinary skill in the art to include a known light stabilizer disclosed by the secondary reference for its concomitant function in the art, i.e. as a light stabilizer, in the recording medium of the primary reference. It is noted that the secondary reference discloses stabilization of polymers, including polyamides, polyesters and styrene butadiene, all of which may be included with polyvinyl alcohol as the binder of the primary reference. Therefore, the secondary reference suggests success when using the disclosed stabilizers to stabilize a layer including one or more of these polymers.

Claims 13-15 and 17 are no longer withdrawn from consideration because they now depend from an elected claim and are not limited to a non-elected species. The primary reference discloses inorganic pigment which may be alumina hydrate or silica in at least one layer (col. 8, lines 59-67). The medium may be more than one layer and it would have been obvious to contain the light stabilizer of the secondary reference in any layer containing the polymer to be stabilized. Thus, the light stabilizer can be used in one or more coating layers.

4. Applicant's arguments filed May 10, 2007 have been fully considered but they are not persuasive. Applicants argue that the light-stabilizer of the secondary reference is a stabilizer for polymers and is not intended as a light-fastness enhancing agent related to the degradation of an ink image. First, this is not persuasive because applicants merely claim an ink receiving layer containing a binder and a compound. Nowhere in the claims do applicants recite that the compound is present to prevent ink-degradation when a printed medium is exposed to light. Second, there is an independent reason for

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including the light stabilizer of the secondary reference in the medium of the primary reference, i.e. it is known to stabilize polymers which are disclosed by the primary reference as binders for the coating layers. While applicants state that "there is minimal concern for the degradation of the polymer" in ink jet media, this is unpersuasive. Ink jet media are known for use in making outdoor displays where degradation of the polymer would be a significant concern.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
July 6, 2007


PAMELA R. SCHWARTZ
PRIMARY EXAMINER